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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,727	11/03/2003	Jonathan D. Root	1001.1426103	3544

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CROMPTON, SEAGER & TUFTE, LLC
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MINNEAPOLIS, MN 55403-2420

EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE.	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

CD

Office Action Summary	Application No. 10/699,727	Applicant(s) ROOT ET AL.	
	Examiner (Jackie) Tan-Uyen T. Ho	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/06 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed on 6/12/06 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made, to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 37-58 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barbut et al. (5,997,557) and further Barbut et al. in view of Winston et al. (6,228,076). Barbut et al. disclose in figure 22, a catheter system comprising an elongate member having a proximal end, a distal end and a first lumen therebetween, an expandable filtration assembly having an expanded configuration that defines a distally facing cavity, the expandable filtration assembly including a filter membrane being attached to the elongate member proximally of the distal end of the elongate member and extending distally

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beyond the distal end of the elongate member, the cavity including a gap between the distal end of the elongate member and the expandable filtration assembly, the gap extending longitudinal both distally and proximally from the distal end and extending radially from the distal end.

Note: The expandable filtration assembly as claimed does not require struts (300).

Barbut et al. also disclose all the limitations of the claims in figs. 1 and 2, except for the expandable filtration assembly being extending distally beyond the distal end of the elongate member or in figure 22, the filtration assembly including support struts being attached to the elongate member proximally of the distal end of the elongate member and the ablation device being a thermal, laser or microwave ablation device.

Regarding to the filtration assembly being extending distally beyond the distal end of the elongate member, it would have been obvious matter of design choice to modify the Barbut reference by having the expandable filtration assembly attached to the elongated member proximally of the distal end of the elongate member and extending distally beyond the distal end of the elongate member, since applicant has not disclosed that the elongate member proximally of the distal end of the elongated member is for any particular purpose or to solve any stated problem and it appears that the device would perform equally well with the expandable filter being attached to the elongate member proximally of the distal end of the elongated member or the expandable filter being attached to the elongate member at the distal end of the elongated member.

Regarding to the remarks filed 11/27/06, applicants argued that it can not be an arbitrary design choice since the attachment point as claimed allows the distal section serving at least two protective functions. However, the original specification does not disclose the distal section

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serving at least two protective functions as listed in the remarks filed on 11/27/06. Also, the distal section of the elongate member as disclosed in figs. 1 and 2 of Barbut reference can serve at least two protective functions as listed in the remarks.

Regarding to the types of the ablation device as claimed, although, the Barbut et al. ablation device is not a thermal, laser or microwave ablation device, attention is directed to the Winston et al. reference which disclose an abnormal tissue ablation apparatus including a thermal, laser or microwave ablation device (col. 4, lines 13-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a thermal, laser or microwave ablation device into the Barbut et al. apparatus wherein so doing would amount to mere substitution of one ablation device for another within the same art that would perform equally well in the Barbut et al. apparatus.

Regarding to claim 56-58, it would have been obvious matter of design choice to modify the Barbut reference having the expandable filtration assembly attached to the elongated member as claimed and the distal end of the elongate member being free from any attachment, since applicant has not disclosed that the expandable filtration assembly attached to the elongated member as claimed and the distal end of the elongate member being free from any attachment is for any particular purpose or to solve any stated problem and it appears that the device would perform equally well with the expandable filter being attached to the elongate member proximally of the distal end of the elongated member or the expandable filter being attached to the elongate member at the distal end of the elongated member.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on Multiflex Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



(Jackie) Tan-Uyen T Ho
Primary Examiner
Art Unit 3731

February 20, 2007